

REMARKS

Claims 1 and 3-33 remain in the application for further prosecution. Claims 1, 3 and 18 have been amended. Claim 2 has been cancelled.

Specification

The specification was objected to because the trademark MONOPOLY was not capitalized when it appeared in the specification. The specification has been revised. The trademark "MONOPOLY" has been capitalized wherever it occurs in the specification.

Claim Rejections - 35 U.S.C. § 102

Claims 1-3, 5, 6, 8-10, 12, 13, 15 and 16 were rejected under 35 U.S.C. § 102(e) as being anticipated by SUPERIOR RACES (Superior Confection Co. of Columbus, Ohio, disclosed by Marshall Fey) ("Superior"). The Office Action alleges that Superior discloses the invention. The Applicants respectfully disagree on the basis that significant claim features and limitations are missing from Superior. One requirement of a *prima facie* case of obviousness is that the prior art references must teach or suggest all claim limitations. The missing claim features and limitations are addressed below.

Not All Claim Limitations Taught Or Suggested

Claims 1 and 9 can be distinguished from Superior by the relative movement that occurs between the discrete symbol and the continuous graphical element or, more specifically as stated in claim 9, movement to adjacent discrete symbol positions.

Claim 1 requires "... a processor operable to rotate the reel to allow the discrete symbols to move relative to the continuous graphical element ..."

Claim 9 requires “. . . a discrete symbol moving between the adjacent ones of the discrete symbol positions as the reel is rotated.”

In contrast, Superior does not alter the position of its discrete symbols (i.e., its colored horses) relative to continuous graphical elements (i.e., the trail -- although the Applicants do not concur with the characterization of the mechanical reel as a continuous graphical element). Superior's colored horses are permanently fixed to the mechanical reel and cannot move relative to the reel.

Requiring relative movement between the discrete symbol and the continuous graphical element is a significant and fundamental claim limitation that is missing from Superior.

Claim Rejections Over SUPERIOR RACES - 35 U.S.C. § 103(a)

Claims 18, 20, 21, 23-26, 28, 29, 31 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Superior. One basic requirement for a *prima facie* case of obviousness is that the prior art references must teach or suggest all of the claim limitations. Superior does not satisfy this requirement.

Not All Claim Limitations Taught Or Suggested

The Office Action states “Superior does not disclose that the slot machines is controlled by a processor or that a player can place a wager . . .” On a more fundamental level, Superior does not disclose, or even suggest, relative movement between the discrete symbols and the continuous graphical element. This relative movement is fundamental for providing game play outcome to the player. This relative movement is a limitation contained in each of independent claims 18 and 25 (and, by inclusion, claims 20, 21, 23-24, 26, 28, 29, 31 and 32 which depend on independent claims 18 or 25) as follows.

Claim 18 requires “. . . moving at least one of the plurality of discrete symbols relative to the graphical element . . .”

Claim 25 requires “. . . moving a discrete symbol between the adjacent ones of the discrete symbol positions as the reel is rotated.”

Relative movement between the discrete symbol and graphical element is a significant and fundamental claim limitation that is missing from the combination of Superior and Taylor. Consequently, a *prima facie* case of obviousness has not been made.

Claim Rejections Over SUPERIOR RACES In View Of Taylor - 35 U.S.C. § 103(a)

Claims 4, 7, 11, 14, 19, 22, 27 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Superior in view of U.S. Patent No. 6,569,013 to Taylor (“Taylor”).

One basic requirement for a *prima facie* case of obviousness is that the prior art references must teach or suggest all of the claim limitations. Superior and Taylor do not satisfy this requirement. All of the dependent claims listed have significant and fundamental limitations that are missing from Superior and Taylor.

Not All Claim Limitations Taught Or Suggested

The Office Action states “Superior does not disclose that the gaming device is available in a simulated video display.” On a more fundamental level, Superior does not disclose, or even suggest, that the discrete symbols may move relative to the continuous graphical element. Taylor is also silent with respect to relative movement. This relative movement is fundamental for providing game play outcome to play.

All of the dependent claims listed above depend from either independent claims 1, 9, 18 or 25. The limitations in each of these independent claims, missing from Superior and Taylor, are quoted below.

Claim 1 requires “. . . a processor operable to rotate the reel to allow the discrete symbols to move relative to the continuous graphical element . . .”

Claim 9 requires “. . . a discrete symbol moving between the adjacent ones of the discrete symbol positions as the reel is rotated.”

Claim 18 requires “. . . moving at least one of the plurality of discrete symbols relative to the graphical element . . .”

Claim 25 requires “. . . moving a discrete symbol between the adjacent ones of the discrete symbol positions as the reel is rotated.”

Relative movement between the discrete symbol and graphical element is a significant and fundamental claim limitation that is missing from the combination of Superior and Taylor. Consequently, a *prima facie* case of obviousness has not been made.

Claim Rejections Over SUPERIOR RACES In View Of Gerrard - 35 U.S.C. § 103(a)

Claims 17 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Superior in view of U.S. Patent No. 6,494,785 to Gerrard (“Gerrard”).

One basic requirement for a *prima facie* case of obviousness is that the prior art references must teach or suggest all of the claim limitations. Superior and Gerrard do not satisfy this requirement. Significant and fundamental limitations included in claims 17 and 33 are missing from Superior and Gerrard.

Not All Claim Limitations Taught Or Suggested

The Office Action states, "Superior does not disclose that a payout accumulates based on the position traversed by each the discrete symbol." On a more fundamental level, Superior does not disclose, or even suggest, that the discrete symbols may move relative to the continuous graphical element. Likewise, Gerrard is also silent with respect to relative movement. The relative movement between the discrete symbol and the continuous graphical element is fundamental for providing the game play outcome to the player.

Dependent claim 17 depends from independent claim 9, and dependent claim 33 depends from independent claim 25. The limitations in each of these independent claims, missing from Superior and Taylor, are quoted below.

Claim 9 requires ". . . a discrete symbol moving between the adjacent ones of the discrete symbol positions as the reel is rotated."

Claim 25 requires ". . . moving a discrete symbol between the adjacent ones of the discrete symbol positions as the reel is rotated."

Relative movement between the discrete symbol and graphical element is a significant and fundamental claim limitation that is missing from the combination of Superior and Gerrard. Consequently, a *prima facie* case of obviousness has not been made.

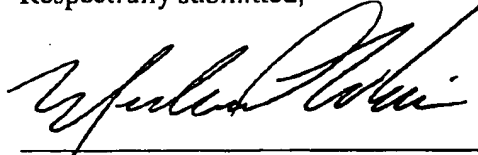
Conclusion

The Applicants believe the claims are in condition for allowance, and action towards that end is earnestly solicited.

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Reply to Office Action dated June 9, 2003

If any matters may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants' undersigned attorney at the number shown.

Respectfully submitted,



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